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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,270	03/24/2004	Ying H. So	43004A	3417

109 7590 06/10/2005

THE DOW CHEMICAL COMPANY  
INTELLECTUAL PROPERTY SECTION  
P. O. BOX 1967  
MIDLAND, MI 48641-1967

EXAMINER

HAMILTON, CYNTHIA

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 06/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/808,270

Applicant(s)

SO ET AL.

Examiner

Cynthia Hamilton

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 2/23/2005, 8/12/04, 3/24/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-22 is/are allowed.
- 6) ☒ Claim(s) 23 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. The examiner has cited in the attached PTO-892 forms all references that were cited during the original prosecution as required in MPEP 1455.
2. With respect to when and how errors were made and/or discovered in the specification of '926 patent, the examiner makes no review. She is informing applicants of this as required in MPEP 1414, II, (B). The identification of one error is all that is required.
3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. The amendment filed 24 March 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

- i. In the replacement paragraph for col. 2, lines 15-36, the added upper limit for acid functional groups at equivalent weight of 570 and 440. Applicants point to support for these corrected upper limits by calculating from support found at column 6, line 35, e.g. the preferred mole ratio of 50:50 of component (a) to (b), and the corrected examples. The examiner notes that applicants do not point to the numbers 550 or 440 anywhere nor to they make calculations to support the use of these specific numbers. The table with the mole fractions set forth on page 6,

Art Unit: 1752

lines 33-36, with the theoretically lowest grams per mole acid functionality also figured. As can be seen, there is no 550 or 440 number.

	mole fraction a	mole fraction b (acid function)	g/mole acid functionality
lowest possible	0.00	1.00	174
	0.10	0.90	217
Example 2	0.20	0.80	272
	0.25	0.75	304
	0.30	0.70	341
Exampe 3	0.40	0.60	434
	0.50	0.50	564
	0.70	0.30	1084

ii. At column 12, the addition of the end of the paragraph of “about 217 g/mole of acid functionality”. This number is the highest possible acid functionality if all of the ester is hydrolyzed. There is no indication how much was hydrolysable, thus, the actual determination of acid functionality must be obtained after hydrolyzation. There is no support for “about 217 g/mole of acid functionality” here. The original specification references both ester functionality and acid functionality. See particularly the paragraph bridging col. 5 and 6.

Applicant is required to cancel the new matter in the reply to this Office Action.

5. Claims 23 and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Art Unit: 1752

a. Applicants have not pointed out sufficiently where the new claim 23 is supported, nor does there appear to be a written description of the claim limitation “to about 440 g/mole of acid functionality” found in the application as filed. See particularly MPEP 2163.04. This is in the last two lines of claim 23 and references the upper limit of acid functionality. The examiner notes that the acid functionality of Example 3 is 434 g/mole of acid functionality. There is no limit of 440 g/mole in an example.

b. Applicants have not pointed out sufficiently where the new claim 24 is supported, nor does there appear to be a written description of the claim limitation “to about 570 g/mole of acid functionality” found in the application as filed. See particularly MPEP 2163.04. This in the last two lines of claim 24 and references the upper limit of acid functionality. The examiner notes that the acid functionality of Example 3 is 434 g/mole of acid functionality. There is no limit of 440 g/mole in an example.

c. Applicants point to support for these corrected upper limits by calculating from support found at column 6, line 35, e.g. the preferred mole ratio of 50:50 of component (a) to (b), and the corrected examples. The examiner notes that applicants do not point to the numbers 550 or 440 anywhere nor to they make calculations to support the use of these specific numbers. The table with the mole fractions set forth on page 6 lines 33-36 with the theoretically lowest grams per mole acid functionality also figured. As can be seen, there is no 550 or 440 number.

	mole fraction a	mole fraction b (acid function)	g/mole acid functionality
lowest possible	0.00	1.00	174
	0.10	0.90	217

Art Unit: 1752

Example 2	0.20	0.80	272
	0.25	0.75	304
	0.30	0.70	341
Exampe 3	0.40	0.60	434
	0.50	0.50	564
	0.70	0.30	1084

- d. Because of this the examiner holds the addition of such limits to the claims is unsupported by the original disclosure in such a way as to reasonably convey to one skilled in the relevant art that the inventors at the time the application was filed had possession of the claimed invention set forth in newly presented claims 23-24.
6. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 6,361,926 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

7. Claims 1-22 are allowed.

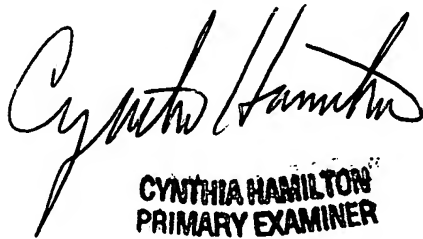
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Hamilton whose telephone number is 571-272-1331.

The examiner can normally be reached on Monday through Friday 9:30 am to 5:00 pm.

Art Unit: 1752

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on (571) 272-0729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**CYNTHIA HAMILTON  
PRIMARY EXAMINER**

Cynthia Hamilton  
Primary Examiner  
Art Unit 1752

March 21, 2005